

Applicant would like to thank Examiner Vu for his time and consideration during the telephone interview on January 28, 2003. Examiner Vu requested Applicant's representative to prepare the Interview Summary record.

During the interview Applicant's representative discussed Claims 1-2 and identified how the claim language differed from the illustrations in Figures 1 and 2. Even though the Examiner agreed that Figures 1 and 2 do not show all the elements of Claims 1-2, the Examiner contends that it would have been obvious to make the claimed invention defined by Claims 1-2. The Examiner has not identified prior art, or the suggestion or motivation required to establish a prima facie case of obviousness. The Examiner stated that he would speak to other Examiners and report his findings/discussions to Applicant's representative.

Applicant's representative also discussed and identified the differences between Claims 1-2 and Tortola. Additionally, Applicant's representative explained the case, *Howard v. Detroit Stove Works*, (cited by the Examiner), and how the case was inapplicable to Tortola. The Examiner contends that it would have been obvious to remove the cable 16 shown in Figure 1 of Tortola and make the connector 18 integral with the housing 12. Applicant's representative argued that the omission of an element with retention of the element's function is an indicia of unobviousness. *M.P.E.P. § 2144.04(II)(B)*.

Claim 1 is rejected under 35 U.S.C. § 102 as being anticipated by Figures 1 and 2 in the application. Amended independent Claim 1 defines a device for transforming the main supply voltage into a lower voltage, comprising a first male connector that can be selectively plugged into a main supply socket, a second male connector that can be selectively plugged into a consumer, and an electronic circuit for transforming the voltage which is located between the two connectors, and wherein the electronic circuit forms with the second connector (2) one rigid physical unit whereby the second connector (2) is supported by the housing.

Figures 1 and 2 do not disclose a first male connector that can be selectively plugged into a main supply socket, a second male connector that can be selectively plugged into a consumer, and an electronic circuit for transforming the voltage which is located between the two connectors, and wherein the electronic circuit forms with the second connector (2) one rigid physical unit whereby the second connector (2) is supported by the housing. Rather, Figures 1 and 2 show a conventional transformer including a second connector that can connect to a consumer, but the second connector does not form one rigid physical unit whereby the second connector is supported by the housing. Therefore, Figures 1 and 2 of the application do not disclose the subject matter of Claim 1.

The Examiner also rejected Claim 1 under 35 U.S.C. § 103 as being unpatentable over Tortola. The Examiner has not provided any correlation between the Tortola reference and the elements of Claim 1. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in the Tortola reference or withdraw the rejection.

Tortola discloses a power pack including a housing and a flexible DC outlet cable 16 having an outlet plug 18. The plug 18 can be connected to a video game 60 when the power pack is in a DC, battery-operated position, such that power is provided to the video game 60 by the battery inside the housing. The outlet plug 18 cannot be used when the power pack is in the AC use, battery-charging position. In the AC use, battery-charging position, a plug 20 is inserted into a standard AC power outlet to charge the battery. The power pack in Tortola does not provide AC power to a consumer, but rather provides AC power to recharge a battery and provides DC power from the battery to the consumer.

The Examiner contends that it would have been obvious to have the male plug being an integral part of the power pack, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, citing *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). The *Howard* case is a patent infringement suit where the patentee asserted infringement of three patents. The patents relate to improvements in stoves. The third patent related to a circular grate, known as the Beckwith grate, is inserted into a fire box. The Court was presented with a grate, known as the Monumental grate, that had all the elements of the Beckwith grate, except that the Monumental grate burned coal and was cast in two pieces. The Court indicated that casting the Beckwith grate in one piece does not involve patentable invention over an article that was formerly cast in two pieces.

Howard is inapplicable to Tortola because the device in Tortola is not a device consisting of separate pieces that could be put together to form the invention as claimed in Claim 1. The Examiner contends there would be two pieces, the housing and the outlet plug 18 if the cable 16 was removed, and that it would be obvious to connect the outlet plug 18 to the housing. Applicant disagrees. By removing an element, e.g., the cable, as shown in Figure 3 of the application, Applicant has removed an element and has retained the function of the element, but has simplified the device to make it more energy efficient and smaller. By removing the cable, the resistance is reduced and less input power is lost such that there is better voltage control and a simplified electronic circuit. The M.P.E.P. states that the "omission of an element with retention of the element's function is an indicia of

unobviousness." *M.P.E.P.* § 2144.04(II)(B). Therefore, Tortola does not teach or suggest the subject matter of Claim 1.

Accordingly, Claim 1 is allowable. Dependent Claims 2-10 depend from Claim 1 and are allowable for the same and other reasons. In addition, the additional subject matter defined by the dependent claims, such as, for example, Claims 2 and 4 provide separate bases for allowance.

Claim 2 specifies that the device further comprises an ON/OFF switch (5) including one of an ON and an OFF state for supplying the line voltage to the consumer. Figures 1 and 2 do not show an ON/OFF switch (5) including one of an ON and an OFF state for supplying the line voltage to the consumer. The Examiner has not provided any correlation between Figures 1 and 2 and the elements of Claim 2. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in Figures 1 and 2 or withdraw the rejection.

Claim 2 was also rejected under 35 U.S.C. § 103 as being unpatentable over Tortola. The Examiner has not provided any correlation between the Tortola reference and the elements of Claim 2. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in the Tortola reference or withdraw the rejection. The Applicant, however, takes the liberty to discuss and distinguish the Tortola reference.

Tortola does not teach or suggest the additional subject matter of Claim 2. Rather, Tortola discloses a power pack including a pivotable plug 20 that moves from a DC, battery-operated position to an AC use, battery-charging position. When the plug 20 is in the DC, battery-operated position, the metal prongs of the plug 20 are in contact with metal clips 44 to insure that power is directed from the battery to the cable 16. When the plug 20 is in the AC use, battery-charging position, and plugged into a power outlet, contact extensions 38 on the plug 20 contact metal tension clips 54 to provide AC power to charge the battery. Tortola does not teach or suggest an ON and an OFF state for supplying the line voltage to the consumer. For these and other reasons, dependent Claim 2 includes additional patentable subject matter.

Claim 4 specifies that the device further comprises an indicator (4) for indicating the operational state of the device. Figures 1 and 2 do not show an indicator for indicating the operational state of the device. The Examiner has not provided any correlation between Figures 1 and 2 and the elements of Claim 4. The Applicant respectfully requests that the

Examiner specifically point out where these claimed elements are shown in Figures 1 and 2 or withdraw the rejection.

Claim 4 was also rejected under 35 U.S.C. § 103 as being unpatentable over Tortola. The Examiner has not provided any correlation between the Tortola reference and the elements of Claim 4. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in the Tortola reference or withdraw the rejection. The Applicant, however, takes the liberty to discuss and distinguish the Tortola reference.

Tortola does not teach or suggest the additional subject matter of Claim 4. Rather, Tortola discloses a power pack including a pivotable plug 20 that moves from a DC, battery-operated position to an AC use, battery-charging position. When the plug 20 is in the DC, battery-operated position, the metal prongs of the plug 20 are in contact with metal clips 44 to insure that power is directed from the battery to the cable 16. When the plug 20 is in the AC use, battery-charging position, and plugged into a power outlet, contact extensions 38 on the plug 20 contact metal tension clips 54 to provide AC power to charge the battery. Tortola does not teach or suggest an indicator for indicating the operational state of the device. For these and other reasons, dependent Claim 4 includes additional patentable subject matter.

Claim 11 is rejected under 35 U.S.C. § 102 as being anticipated by Figures 1 and 2 in the application. Amended independent Claim 11 defines a device for converting a main supply voltage to a lower voltage. The device includes a housing; a first male connector coupled to the housing, the first male connector operable to connect to a main supply voltage; and a second male connector supported by the housing, and being operable to connect to an electronic device.

Figures 1 and 2 do not disclose a first male connector coupled to the housing, the first male connector operable to connect to a main supply voltage, and a second male connector supported by the housing, and being operable to connect to an electronic device. Rather, Figures 1 and 2 show a conventional transformer including a second connector that can connect to a consumer, but the second connector is not supported by the housing. Therefore, Figures 1 and 2 of the application do not disclose the subject matter of Claim 11.

The Examiner also rejected Claim 11 under 35 U.S.C. § 103 as being unpatentable over Tortola. The Examiner has not provided any correlation between the Tortola reference and the elements of Claim 11. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in the Tortola reference or withdraw the rejection.

Tortola does not teach or suggest a device for converting a main supply voltage to a lower voltage including a second male connector that is supported by the housing and operable to connect to an electronic device. Rather, Tortola discloses a power pack including a housing and a flexible DC outlet cable 16 having an outlet plug 18. The plug 18 can be connected to a video game 60 when the power pack is in a DC, battery-operated position, such that power is provided to the video game 60 by the battery inside the housing. The outlet plug 18 cannot be used when the power pack is in the AC use, battery-charging position. In the AC use, battery-charging position, a plug 20 is inserted into a standard AC power outlet to charge the battery. The power pack in Tortola does not provide AC power to a consumer, but rather provides AC power to recharge a battery and provides DC power from the battery to the consumer.

The Examiner contends that it would have been obvious to have the male plug being an integral part of the power pack, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, citing *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). The *Howard* case is a patent infringement suit where the patentee asserted infringement of three patents. The patents relate to improvements in stoves. The third patent related to a circular grate, known as the Beckwith grate, is inserted into a fire box. The Court was presented with a grate, known as the Monumental grate, that had all the elements of the Beckwith grate, except that the Monumental grate burned coal and was cast in two pieces. The court indicated that casting the Beckwith grate in one piece does not involve patentable invention over an article that was formerly cast in two pieces.

Howard is inapplicable to Tortola because the device in Tortola is not a device consisting of separate pieces that could be put together to form the invention as claimed in Claim 11. The Examiner contends there would be two pieces, the housing and the outlet plug 18 if the cable 16 was removed, and that it would be obvious to connect the outlet plug 18 to the housing. Applicant disagrees. By removing an element, e.g., the cable, as shown in Figure 3 of the application, Applicant has removed an element and has retained the function of the element, but has simplified the device to make it more energy efficient and smaller. By removing the cable, the resistance is reduced and less input power is lost such that there is better voltage control and a simplified electronic circuit. The M.P.E.P. states that the "omission of an element with retention of the element's function is an indicia of unobviousness." *M.P.E.P. § 2144.04(II)(B)*. Therefore, Tortola does not teach or suggest the subject matter of Claim 11.

Accordingly, Claim 11 is allowable. Dependent Claims 12-14 depend from Claim 11 and are allowable for the same and other reasons. In addition, the additional subject matter defined by Claim 13 provides separate bases for allowance.

Claim 13 specifies that the device further comprises a switch coupled to the housing and operable to control the main supply voltage to the electronic circuit. Figures 1 and 2 do not show a switch coupled to the housing. The Examiner has not provided any correlation between Figures 1 and 2 and the elements of Claim 13. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in Figures 1 and 2 or withdraw the rejection.

Claim 13 is also rejected under 35 U.S.C. § 103 as being unpatentable over Tortola. The Examiner has not provided any correlation between the Tortola reference and the elements of Claim 13. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in the Tortola reference or withdraw the rejection.

Tortola does not teach or suggest the additional subject matter of Claim 13. Rather, Tortola discloses a power pack including a pivotable plug 20 that moves from a DC, battery-operated position to an AC use, battery-charging position. When the plug 20 is in the DC, battery-operated position, the metal prongs of the plug 20 are in contact with metal clips 44 to insure that power is directed from the battery to the cable 16. When the plug 20 is in the AC use, battery-charging position, and plugged into a power outlet, contact extensions 38 on the plug 20 contact metal tension clips 54 to provide AC power to charge the battery. Tortola does not teach or suggest a switch coupled to the housing. For these and other reasons, dependent Claim 13 includes additional patentable subject matter.

Claim 15 is rejected under 35 U.S.C. § 102 as being anticipated by Figures 1 and 2 in the application. Amended independent Claim 15 defines a device for transforming a main supply voltage. The device includes a housing including an electronic circuit for transforming the main supply voltage; a first electrical male plug coupled to the housing for connection with an electrical outlet supplying the main voltage; a second electrical male plug supported by the housing for connection to an electronic device; and a switch coupled to the housing to control the supply of voltage to the electronic circuit.

Figures 1 and 2 do not disclose a first electrical male plug coupled to the housing for connection with an electrical outlet supplying the main voltage; a second electrical male plug supported by the housing for connection to an electronic device; and a switch coupled to the housing to control the supply of voltage to the electronic circuit. Rather, Figures 1 and 2

show a conventional transformer including a second connector, but the second connector is not supported by the housing. Therefore, Figures 1 and 2 of the application do not disclose the subject matter of Claim 15.

The Examiner also rejected Claim 15 under 35 U.S.C. § 103 as being unpatentable over Tortola. The Examiner has not provided any correlation between the Tortola reference and the elements of Claim 15. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in the Tortola reference or withdraw the rejection.

Tortola does not teach or suggest a device for transforming a main supply voltage including a second electrical male plug supported by the housing for connection to an electronic device. Rather, Tortola discloses a power pack including a housing and a flexible DC outlet cable 16 having an outlet plug 18. The plug 18 can be connected to a video game 60 when the power pack is in a DC, battery-operated position, such that power is provided to the video game 60 by the battery inside the housing. The outlet plug 18 cannot be used when the power pack is in the AC use, battery-charging position. In the AC use, battery-charging position, a plug 20 is inserted into a standard AC power outlet to charge the battery. The power pack in Tortola does not provide AC power to a consumer, but rather provides AC power to recharge a battery and provides DC power from the battery to the consumer.

The Examiner contends that it would have been obvious to have the male plug being an integral part of the power pack, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, citing *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). The *Howard* case is a patent infringement suit where the patentee asserted infringement of three patents. The patents relate to improvements in stoves. The third patent related to a circular grate, known as the Beckwith grate, is inserted into a fire box. The Court was presented with a grate, known as the Monumental grate, that had all the elements of the Beckwith grate, except that the Monumental grate burned coal and was cast in two pieces. The court indicated that casting the Beckwith grate in one piece does not involve patentable invention over an article that was formerly cast in two pieces.

Howard is inapplicable to Tortola because the device in Tortola is not a device consisting of separate pieces that could be put together to form the invention as claimed in Claim 15. The Examiner contends there would be two pieces, the housing and the outlet plug 18 if the cable 16 was removed, and that it would be obvious to connect the outlet plug 18 to the housing. Applicant disagrees. By removing an element, e.g., the cable, as shown in

Figure 3 of the application, Applicant has removed an element and has retained the function of the element, but has simplified the device to make it more energy efficient and smaller. By removing the cable, the resistance is reduced and less input power is lost such that there is better voltage control and a simplified electronic circuit. The M.P.E.P. states that the "omission of an element with retention of the element's function is an indicia of unobviousness." *M.P.E.P.* § 2144.04(II)(B).

Tortola also does not teach or suggest a device for transforming the main supply voltage including a switch coupled to the housing to control the supply of voltage to the electronic circuit. Rather, Tortola discloses a power pack including a pivotable plug 20 that moves from a DC, battery-operated position to an AC use, battery-charging position. When the plug 20 is in the DC, battery-operated position, the metal prongs of the plug 20 are in contact with metal clips 44 to insure that power is directed from the battery to the cable 16. When the plug 20 is in the AC use, battery-charging position, and plugged into a power outlet, contact extensions 38 on the plug 20 contact metal tension clips 54 to provide AC power to charge the battery. Tortola does not teach or suggest an ON and an OFF state for supplying the line voltage to the consumer.

Therefore, Tortola does not teach or suggest the subject matter of Claim 15. Accordingly, Claim 15 is allowable. Dependent Claim 16 depends from Claim 15 and is allowable for the same and other reasons.

Claim 17 is rejected under 35 U.S.C. § 102 as being anticipated by Figures 1 and 2 in the application. Amended independent Claim 17 defines a device for transforming the main supply voltage into a lower voltage. The device includes a first connector that can be plugged into a main supply socket, a second connector that can be plugged into a consumer and an electronic circuit for transforming the voltage which is located within a housing between the two connectors, and wherein the second connector (2) is supported by the housing.

Figures 1 and 2 do not disclose a first connector that can be plugged into a main supply socket, a second connector that can be plugged into a consumer and an electronic circuit for transforming the voltage which is located within a housing between the two connectors, and wherein the second connector (2) is supported by the housing. Rather, Figures 1 and 2 show a conventional transformer including a second connector, but the second connector is not supported by the housing. Therefore, Figures 1 and 2 of the application do not disclose the subject matter of Claim 17.

The Examiner also rejected Claim 17 under 35 U.S.C. § 103 as being unpatentable over Tortola. The Examiner has not provided any correlation between the Tortola reference and the elements of Claim 17. The Applicant respectfully requests that the Examiner specifically point out where these claimed elements are shown in the Tortola reference or withdraw the rejection.

Tortola does not teach or suggest a device for transforming a main supply voltage into a lower voltage including a second connector that can be plugged into a consumer and an electronic circuit for transforming the voltage which is located within a housing between the two connectors, and wherein the second connector (2) is supported by the housing. Rather, Tortola discloses a power pack including a housing and a flexible DC outlet cable 16 having an outlet plug 18. The plug 18 can be connected to a video game 60 when the power pack is in a DC, battery-operated position, such that power is provided to the video game 60 by the battery inside the housing. The outlet plug 18 cannot be used when the power pack is in the AC use, battery-charging position. In the AC use, battery-charging position, a plug 20 is inserted into a standard AC power outlet to charge the battery. The power pack in Tortola does not provide AC power to a consumer, but rather provides AC power to recharge a battery and provides DC power from the battery to the consumer.

The Examiner contends that it would have been obvious to have the male plug being an integral part of the power pack, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, citing *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). The *Howard* case is a patent infringement suit where the patentee asserted infringement of three patents. The patents relate to improvements in stoves. The third patent related to a circular grate, known as the Beckwith grate, is inserted into a fire box. The Court was presented with a grate, known as the Monumental grate, that had all the elements of the Beckwith grate, except that the Monumental grate burned coal and was cast in two pieces. The court indicated that casting the Beckwith grate in one piece does not involve patentable invention over an article that was formerly cast in two pieces.

Howard is inapplicable to Tortola because the device in Tortola is not a device consisting of separate pieces that could be put together to form the invention as claimed in Claim 17. The Examiner contends there would be two pieces, the housing and the outlet plug 18 if the cable 16 was removed, and that it would be obvious to connect the outlet plug 18 to the housing. Applicant disagrees. By removing an element, e.g., the cable, as shown in Figure 3 of the application, Applicant has removed an element and has retained the function

of the element, but has simplified the device to make it more energy efficient and smaller. By removing the cable, the resistance is reduced and less input power is lost such that there is better voltage control and a simplified electronic circuit. The M.P.E.P. states that the "omission of an element with retention of the element's function is an indicia of unobviousness." *M.P.E.P. § 2144.04(II)(B)*. Therefore, Tortola does not teach or suggest the subject matter of Claim 17.

Accordingly, Claim 17 is allowable.

CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of Claims 1-17 are respectfully requested. The undersigned is available for a telephone consultation at any time.

Respectfully submitted,



Thomas A. Miller

Reg. No. 36,871

Docket No. 041165-9014-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560

AMENDED CLAIMS
MARKED-UP VERSION

1. (Fourth Amendment) Device for transforming the main supply voltage into a lower voltage, comprising a first male connector that can be selectively plugged into a main supply socket, a second male connector that can be selectively plugged into a consumer, and an electronic circuit for transforming the voltage which is located between the two connectors, and wherein the electronic circuit forms with the second connector (2) one rigid physical unit whereby the [connection between the electronic circuit and second connector (2) is as short as possible and has a low electric resistance] second connector (2) is supported by the housing.

11. (Second Amendment) A device for converting a main supply voltage to a lower voltage comprising:

a housing;

a first male connector coupled to the housing [for connection], the first male connector operable to connect to a main supply voltage; and

a second male connector [releasably coupled directly to] supported by the housing [for connection], and being operable to connect to an electronic device [such that the second connector and the housing form a rigid unit when coupled together].

13. (Second Amendment) A device as claimed in claim 11, further comprising a switch coupled to the housing [for controlling] and operable to control the main supply voltage to the electronic circuit.

15. (Second Amendment) A device for transforming a main supply voltage comprising:

a housing including an electronic circuit for transforming the main supply voltage;

a first electrical male plug coupled to the housing for connection with an electrical outlet supplying the main voltage;

a second electrical male plug [releasably coupled to] supported by the housing for connection to an electronic device[, the second electrical plug and the housing forming a rigid unit when coupled together]; and

a switch coupled to the housing to control the supply of voltage to the electronic circuit.

17. (Amended) Device for transforming the main supply voltage into a lower voltage, comprising a first connector that can be plugged into a main supply socket, a second connector that can be plugged into a consumer and an electronic circuit for transforming the voltage which is located within a housing between the two connectors, and wherein the second connector (2) is [arranged at] supported by the housing [in a way that the second connector forms one rigid physical unit with the housing whereby the connection between the electronic circuit and second connector (2) is as short as possible and has a low electric resistance].